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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/779,405

02/12/2004

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EXAMINER

HYLINSKI, ALYSSA MARIE

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

07/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/779,405

Applicant(s)

KYNE ET AL.

Examiner

Alyssa M. Hylinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 1-3, 5-10, 12-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dods (6152298), Lapides (3173540) and Goldfarb (6287492). Dods discloses a backing sheet (22) with a toy (14) that can take the shape of a character (column 2 lines 17-20) and panel (12) associated with the backing sheet (Fig. 1) by a transparent cover blister (Fig. 2) that substantially encloses the toy and panel (Fig. 1). A toy support blister (18) supports the toy and is located such that the panel is located between the support and cover blisters (column 6 lines 15-21). A panel support blister (30) is disposed between the panel and the backing sheet (Fig. 2). Both support blisters support the panel (Fig. 2). The panel includes an image that is associated with the toy and functions as part of a base (Figs. 1 & 3). The device of Dods discloses the basic inventive concept, substantially as claimed, with the exception of the backing sheet having an aperture with which the panel is aligned and the panel being a lithophane panel. Lapides discloses packaging for an object having a cover and backing sheets (Fig. 3) with apertures (12) formed therein and in which is aligned an object (Fig. 1), showing this feature to be old in the display packaging art. It would have been obvious to one of ordinary skill in the art from the teaching of Lapides to include an aperture in the backing sheet of Dods in order to not hinder a potential purchaser's view of the item while still in the packaging. Goldfarb discloses a lithophane-type panel (903) that can be attached to a toy figure (Fig. 20) to create interesting visual displays when backlit (column 8 lines 5-7). Although the reference does not disclose a panel that is separate

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from the toy and functions as a base, it does disclose using a lithophane-type panel with a toy figure (Fig. 20) and furthermore rearrangement of the location and position of the plate is not a patentable advance. *See In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)*. Therefore, it would have been obvious to one of ordinary skill in the art from the teaching of Goldfarb to utilize lithophane-type panels in conjunction with toy action figures since lithophanes create beautiful and interesting effects that can amuse or delight a child. Even though Goldfarb discloses the lithophane panel is made from a pliable and compressible material, it is still capable of being packaged and the examiner notes that a mere selection of known materials, on the basis of suitability for the intended use would be entirely obvious. *See in re Leshin, 125 USPQ 416 (CCPA 1960)*.

2. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dods, Lapides and Goldfarb. The references disclose the basic inventive concept, substantially as claimed, with the exception of including a plurality of toys and panels. It would have been obvious to one of ordinary skill in the art to multiply the number toys and panels, since such a modification would have involved a mere duplication of parts. A duplication of parts is generally recognized as being within the general skill of a worker in the art. *See In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)*.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dods, Lapides, Goldfarb and Mickelberg (5289916). The references disclose the basic inventive concept, substantially as claimed, with the exception of having an indication that the panel is viewable when backlit. Mickelberg discloses a packaged toy having

instructions or indicia on the packaging to alert a person to features available from the toy while still packaged (Fig. 1). Although the reference does not expressly teach an indication that a panel is viewable when backlit it teaches providing instructions to a potential consumer on the packaging.

Response to Arguments

4. Applicant's arguments filed 5/14/07 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., lithophanes not incorporating reversed images and being translucent) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. In response to applicant's argument that the references cannot be combined since the Dods reference must utilize a trading card and Goldfarb does not disclose the toy being packaged, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Therefore the references teach the utilization of a lithophane type panel with a toy and the packaging of diverse articles.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hylinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH


EUGENE KIM
SUPERVISORY PATENT EXAMINER